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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

05725.1213-00

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Application Number

10/603,698

Filed

June 26, 2003

First Named Inventor

Nadia GARDEL

Art Unit

1617

Examiner

K. R. McMillian

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐ applicant/inventor.

☐ assignee of record of the entire interest.

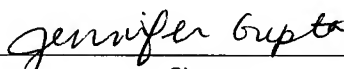
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.

☐ attorney or agent of record.

Registration number _____

☒ attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34 54,257


Signature

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Typed or printed name

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February 1, 2010
Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

☒ *Total of 1 form is submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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PRE-APPEAL BRIEF REQUEST FOR REVIEW

In reply to the Final Office Action dated August 5, 2009 ("Office Action"), Applicants respectfully request panel review of this application. This request is being filed in conjunction with a Notice of Appeal under 37 C.F.R. § 41.31, appropriate appeal fee payment, and a completed PTO/SB/33. No amendments are filed with this Request.

REMARKS

The arguments raised below are not comprehensive of Applicants' objections to the Office Action, but represent a summary of the prosecution history, which Applicants specifically incorporate by reference herein. Applicants reserve the right to raise additional arguments on appeal, including arguments not raised here.

I. Provisional Obviousness-Type Double Patenting Rejections

Claims 1, 17, 19-95 and 99 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 80-83, 86-93, 97-100, and 104-186 of co-pending Application No. 10/784,909 ("the '909 application"), and over claims 1-41 of co-pending Application No. 10/849,825 ("the '825 application") in view of U.S. Patent No. 5,919,468 ("Bara '468"). Office Action at pp. 6-8. Since the present application is the earlier filed of the co-pending applications, and Applicants have overcome the other grounds of rejections for the reasons discussed below, Applicants respectfully request that the Examiner withdraw the "provisional" non-statutory obviousness-type double patenting rejections over the '909 and '825 applications and allow the present application to issue without requiring that a terminal disclaimer be filed in this application.

II. Rejections under 35 U.S.C. § 103

Claims 1, 17, 19-42, 49, 70-95 and 99 are rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over U.S. Patent No. 5,843,417 to Hanna et al. (“Hanna”). *Id.* at p. 9.

Claims 43-47 and 53-69 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Hanna as applied to claims 1, 17, 19-42, 49, 70-95 and 99 above, and further in view of U.S. Patent No. 4,552,753 to Elm et al. (“Elm”) and as evidenced by the Aldrich Catalog 2003-2004 (“Aldrich Catalog”). *Id.* at 13. Claims 48 and 50-52 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Hanna as applied to claims 1, 17, 19-42, 49, 70-95 and 99 above, and further in view of U.S. Patent No. 6,224,851 B1 to Bara et al. (“Bara ’851”). *Id.* at 14. Applicants submit that the claimed invention is not obvious in view of cited references for the reasons of record as well as additional reasons set forth below.

A. Hanna does not teach or suggest all the claimed limitations.

Applicants maintain that the Examiner has not established a *prima facie* case of obviousness over Hanna. In order to meet the initial burden of establishing a *prima facie* case of obviousness, the Examiner first must show that the prior art reference teaches or suggests all the claim limitations. *See In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (CCPA 1974). Here, the Examiner failed to meet this burden because Hanna does not teach or suggest all the elements of the present claims. The present claims require “at least one surfactant chosen from C₈-C₂₂ alkyl dimethicone copolyols,” and “at least one other surfactant chosen from dimethicone copolyols, wherein the at least one other surfactant chosen from dimethicone copolyols is present in an amount of ranging from 5% to 10% by weight.” That is, the range of 5% to 10% refers to the amount of the at least one other surfactant chosen from dimethicone copolyols alone, not the

total amount of both surfactants, *e.g.*, both the at least one C₈-C₂₂ alkyl dimethicone copolyol and the at least one other dimethicone copolyol. In contrast, Hanna teaches that the TOTAL amount of all oil surfactant(s) in a W/O emulsion is in the range of 5%-15%.¹ Hanna at col. 5, lines 29-31. In the sole working example, Hanna lists only a single number of 9% for all oil surfactants (polyglyceryl-4-isostearate/cetyl dimethicone copolyol/hexyl laurate) used, without specifying the amount of any individual oil surfactant. *See id.* at col. 7, lines 47-48. However, Hanna fails to teach or suggest that in addition to at least one C₈-C₂₂ alkyl dimethicone copolyol, another dimethicone copolyol is present in an amount ranging from 5% to 10% by weight as recited in claim 1. Indeed, the Examiner admits that Hanna is deficient in this regard. *See* Office Action at p. 11. Therefore, the teachings of Hanna are not sufficient to render the present claims *prima facie* obvious.

B. Hanna does not recognize the amount of an individual oil surfactant as a result-effective variable.

The Examiner concedes that Hanna does not “specifically teach that the W/O emulsion contains a C₈-C₂₂ alkyl dimethicone copolyol and another dimethicone copolyol wherein the dimethicone copolyol is present in an amount ranging from 5% to 10% by weight.” Office Action at p. 11. The Examiner asserts that “it is obvious to vary and/or optimize the amount of ingredients provided in the composition, according to the guidance provided by Hanna et al. to provide a composition having the desired properties such as the desired ratios, concentrations, percentages, etc.” Office Action at p. 3. Hanna, however, does not recognize the amount of an individual oil surfactant as a result-effective parameter and, thus, it would not have been obvious to one of ordinary skill in the art to determine the amount of each individual oil surfactant through routine or manipulative experimentation. *See* MPEP § 2144.05(II)(B) (“A particular

¹ Dimethicone copolyol and cetyl dimethicone copolyol, which is a C₈-C₂₂ alkyl dimethicone copolyol, are

parameter must first be recognized as a result-effective variable, i.e., a variable which achieves a recognized result, before the determination of the optimum or workable ranges of said variable might be characterized as routine experimentation”).

Further, Hanna prefers an emulsion “contain[ing] at least two different types of surfactants, one being a ‘oil surfactant’ having a hydrophobic-lipophobic balance (HLB) of from 3-4.5, the other being a ‘water surfactant’ having an HLB of 5.5-7.5.” Hanna at col. 1, line 66, to col. 2, line 3. Hanna teaches the total amount of oil surfactants and the amount of water surfactants. *Id.* at col. 5, lines 29-33. Thus, viewing Hanna’s teachings as a whole, an ordinary artisan would optimize the ratio of the oil and water surfactants, *e.g.*, adjusting the total amount of the oil surfactants versus that of the water surfactants, rather than an individual oil surfactant.

C. The claimed invention has unpredictable and superior results.

Finally, Applicants previously submitted a Declaration under 37 C.F.R. § 1.132 (“Declaration”) executed by Ozée Emmanuelle on December 8, 2008, providing experiments that demonstrated that the claimed invention has unpredictable and superior results. *See* Declaration at ¶ 11. The Examiner dismisses Applicants’ Declaration and asserts that “the results are not viewed as unexpected results since Hanna et al. teach that W/O emulsions preferably contain one or more surfactants to stabilize the emulsion.” *See* Office Action at p. 5. Applicants respectfully disagree.

Inventive composition 1 in the Declaration comprises 0.8% cetyl dimethicone copolyol, 5% of dimethicone copolyol, and 0.6% of polyglycerylisostearate. Comparative composition B in the Declaration comprises 0.8% cetyl dimethicone copolyol, 4% dimethicone copolyol, and

exemplified oil surfactants in Hanna. *See id.* at col. 5, lines 3-7.

0.6% polyglyceryl isostearate². This comparative composition is representative of a composition disclosed in Hanna. The total amount of oil surfactants in comparative Composition B is 5.4%, and thus falls within the range of 5%-15% in Hanna, but outside the range of 5% to 10% for dimethicone copolyol as claimed.

The results revealed that Inventive composition 1 has significantly higher viscosity and stability, and better homogeneity than comparative Composition B. This testing clearly establishes that there is unpredictability resulting from the amount of dimethicone copolyol present in the composition. Because of the lack of predictability, Applicants submit that the Examiner failed to establish a *prima facie* case of obviousness based on Hanna.

In view of the foregoing, Applicants submit that the rejection of claims 1, 17, 19-42, 49, 70-95 and 99 under § 103 is improper and should be withdrawn.

The secondary references, Elm, the Aldrich Catalog, and Bara '851, do not cure the deficiencies of Hanna set forth above. Thus, the Examiner has not established a *prima facie* case of obviousness with respect to claims 43-48, and 50-69.

In view of the foregoing, Applicants respectfully request that the Panel withdraw all of the outstanding rejections for at least the reasons stated above. Please grant any extensions of time required to enter this response and charge any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: February 1, 2010

By: Jennifer R. Gupta
Jennifer R. Gupta
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² Each of the oil surfactants in comparative Composition B are listed as examples of oil surfactants in Hanna. See col. 5, lines 3-7.